

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-12 and 16-27 are pending in the application, with 1 and 16 being the independent claims. Claims 13-15 and 28-45 are withdrawn from consideration due to a restriction. Claims 1, 4, 7-12, 16, 19, and 22-27 are sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Information Disclosure Statements***

The Examiner has indicated that forms PTO-1449 for the Information Disclosure Statements submitted on April 3, 2002; August 21, 2003; and February 18, 2004 are missing from the record. (See Office Action, pages 2-3). Accordingly, the Examiner has requested that the Applicants resubmit the forms PTO-1449 for these Information Disclosure Statements. (See Office Action, page 3).

Applicants have included, with this reply, courtesy copies of the Information Disclosure Statements originally submitted on April 3, 2002; August 21, 2003; and February 18, 2004. Each courtesy copy includes copies of forms PTO-1449 originally submitted as well as a copy of a date stamped postcard to prove the filing date of the original submission. Applicants request the Examiner to consider the courtesy copies of

forms PTO-1449 and provide an indication of the Examiner's consideration of these documents in a future communication.

***Rejections under 35 U.S.C. § 103***

***Claims 1, 2, 4, 6, 7, 9-11, 16, 17, 19, 21, 22, 24-26***

The Examiner has rejected claims 1, 2, 4, 6, 7, 9-11, 16, 17, 19, 21, 22 and 24-26 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 6,516,341 to Shaw *et al.* ("Shaw") in view of U.S. Patent 5,848,396 to Gerace ("Gerace"). (See Office Action, page 3). Although the Applicants respectfully disagree, Applicants believe these rejections are incorrect and/or moot in light of the above amendments.

For the Examiner's convenience, independent claim 1 as amended is recited below.

1. A computer implemented method for placing advertisements with interactive content on mobile, hand-held devices, comprising the steps of:
  - (1) displaying an advertisement with interactive content on a hand-held device, wherein **the advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device, the web page including a web based form having one or more fields;**
  - (2) **pre-populating at least one field of the advertisement with address location information relating to the user of the hand-held device;** and
  - (3) conditionally forwarding the at least one pre-populated field to an entity associated with the advertisement to provide information regarding the user to the entity.

Assuming for the sake of argument that the combination of Shaw and Gerace is proper, Shaw and Gerace, alone or in combination, do not teach or suggest each and every element, limitation, and/or feature of amended independent claim 1. Neither Shaw

nor Gerace teach or suggest, for example, the steps of “displaying an advertisement with interactive content on a hand-held device, wherein the advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device, the web page including a web based form having one or more fields” and “pre-populating at least one field of the advertisement with address location information relating to the user of the device.” Shaw is directed toward an offline email browsing system that displays advertisements. (See Shaw, abstract). Gerace is a directed toward a system for displaying, for example, a homepage that includes advertisements based on a user profile formed by monitoring a user’s viewing of agate information. (See Gerace, abstract, column 4, lines 1-6). Although Shaw and Gerace each disclose an aspect of presenting an advertisement to a user, neither Shaw nor Gerace teach or suggest, for example, the steps of presenting an advertisement to a user wherein the advertisement includes, for example, a HTML form with one of the fields pre-populated with address location information of the user.

Furthermore, neither Shaw nor Gerace, alone or in combination, teach or suggest an “advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device.” As admitted by the Examiner, “Shaw does not explicitly disclose that the advertisement is at least a portion of a web page adapted for the device” and therefore, Shaw does not teach or suggest adapting a web page based on the *display characteristics of a device*. (See Office Action, page 8). Gerace fails to overcome, for example, this deficiency of Shaw since Gerace discloses adapting content based only on user *preferences*. (See Gerace, Col 5, lines 15-25). For example, Gerace discloses providing content based on the user's display *preferences*

relating to "orientation, color scheme, screen quadrant/location and the like." (See Gerace, Col. 6, lines 31-37). In another example, Gerace discloses providing content based on the user's application *preferences* for viewing content such as on the user's "own e-mail service or on a text-only browser." (See Gerace, Col. 12, lines 47-55). Gerace does not teach or suggest adapting a web-page based on the *display characteristics of the hand-held device*. Therefore, for at least the reasons stated above, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1, and allowance thereof.

Claims 2, 4, 6, 7 and 9-11 depend from independent claim 1 and are patentable for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2, 4, 6, 7 and 9-11, and allowance thereof.

Assuming for the sake of argument that the combination of Shaw and Gerace is proper, Shaw and Gerace, alone or in combination, do not teach or suggest each and every element, limitation, and/or feature of amended independent claim 16. Neither Shaw nor Gerace teach or suggest, for example, "displaying means for enabling a processor to display an advertisement with interactive content on a hand-held device, wherein the advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device, the web page including a web based form having one or more fields" and "pre-populating means for enabling a processor to pre-populate at least one field of the advertisement with address location information about the user of the hand-held device." For at least the reasons stated

above, claim 16 is patentable over Shaw. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 16, and allowance thereof.

Claims 17, 19, 21, 22 and 24-26 depend from independent claim 16 and are patentable for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 17, 19, 21, 22 and 24-26, and allowance thereof.

***Claims 3, 5, 18, 20***

The Examiner has rejected claims 3, 5, 18 and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of U.S. Patent 6,794,210 to Goldhaber *et al.* ("Goldhaber"). (See Office Action, page 10). Although the Applicants respectfully disagree, Applicants believe these rejections are incorrect and/or moot in light of the above amendments.

Goldhaber, Shaw, and Gerace, alone or in combination, do not teach or suggest each and every element, limitation, and/or feature of claims 3, 5, 18 and 20. Claims 3 and 5 depend from independent claim 1. Claims 18 and 20 depend from independent claim 16. With respect to independent claims 1 and 16, Goldhaber fails to overcome the deficiencies of Shaw and Gerace, alone or in combination. For example, Goldhaber does not teach or suggest "displaying an advertisement with interactive content on a hand-held device, wherein the advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device, the web page including a web based form having one or more fields" and "pre-populating at least one

field of the advertisement with address location information relating to the user of the device.” Hence, claims 3, 5, 18 and 20 are patentable over Goldhaber, Shaw, and Gerace, alone or in combination, for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3, 5, 18 and 20, and allowance thereof.

***Claims 8, 23***

The Examiner has rejected claims 8 and 23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of U.S. Patent 6,332,127 to Bandera *et al.* ("Bandera"). (See Office Action, page 7). Although the Applicants respectfully disagree, Applicants believe these rejections are incorrect and/or moot in light of the above amendments.

Bandera, Shaw and Gerace, alone or in combination, do not teach or suggest each and every element, limitation, and/or feature of claims 8 and 23. Claim 8 depends from independent claim 1. Claim 23 depends from independent claim 16. With respect to independent claims 1 and 16, Bandera fails to overcome the deficiencies of Shaw and Gerace, alone or in combination. For example, Bandera does not teach or suggest displaying an advertisement with interactive content on a hand-held device, wherein the advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device, the web page including a web based form having one or more fields” and “pre-populating at least one field of the advertisement with address location information relating to the user of the device.”

Hence, claims 8 and 23 are patentable over Bandera, Shaw and Gerace, alone or in combination, for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 8 and 23, and allowance thereof.

***Claims 12, 27***

The Examiner has rejected claims 12 and 27 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of U.S. Patent 5,933,811 to Angles *et al.* ("Angles"). (See Office Action, page 8). Although the Applicants respectfully disagree, Applicants believe these rejections are incorrect and/or moot in light of the above amendments.

Angles, Shaw and Gerace, alone or in combination, do not teach or suggest each and every element, limitation, and/or feature of claims 12 and 27. Claim 12 depends from independent claim 1. Claim 27 depends from independent claim 16. With respect to independent claims 1 and 16, Angles fails to overcome the deficiencies of Shaw and Gerace, alone or in combination. For example, Angles does not teach or suggest displaying an advertisement with interactive content on a hand-held device, wherein the advertisement is at least a portion of a web page adapted for the hand-held device based on display characteristics of the hand-held device, the web page including a web based form having one or more fields" and "pre-populating at least one field of the advertisement with address location information relating to the user of the device." Hence, claims 12 and 27 are patentable over Angles, Shaw and Gerace, alone or in

combination, for at least the reasons stated above, in addition to the elements, limitations, and/or features recited therein. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 12 and 27, and allowance thereof.



***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read 'Jeffrey S. Weaver', followed by a horizontal line.

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